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Pandiscio & Pandiscio 470 Totten Pond Road Waltham, MA 02451-1914			ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/761,506	DOHERTY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Nicholas D. Rosen	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 16 May 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-37 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claims 1-37 have been examined.

### ***Claim Objections***

Claim 13 is objected to because of the following informalities: The phrase "the computer program" lacks antecedent basis. It appears that claim 13 may have been intended to depend on claim 12 rather than claim 1. Appropriate correction is required.

Claims 27-31 are objected to because of the following informalities: In claim 27, "multi-media" is hyphenated, which is inconsistent with the usage "multimedia" in claim 1, and in claims 28, 29, and 30. Appropriate correction is required.

Examiner wishes to observe that a rejection under 35 U.S.C. 112 (second paragraph) was overcome by amending claim 24 to provide antecedent basis for a media buyer. It appears that claim 24 may have been intended to depend on claim 22, rather than claim 21, in which case the problem would not have arisen. Applicants may wish to consider appropriate modification of the claims and their dependency.

Claim 36 is objected to because of the following informalities: Because claim 36 is a method claim, the last line should recite "delivering," rather than "delivery means for delivering." Also, in the thirteenth line of the claim, "advertisement selection includes" should be "advertisement selection including". Appropriate correction is required.

Claim 37 is objected to because of the following informalities: Because claim 37 is a method claim, the last element should recite a method step such as "placing a hyperlink," rather than "a hyperlink." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: any relationship between the proper system components and means in claim 1, and the advertisement charge of claim 27. A system might include, e.g., means for assessing an advertisement charge, but an advertisement charge as such is not a part of a system as recited in claim 1, and bears no defined structural relationship to the actual elements of the system.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: any relationship between the proper system components, and the "fee charged to the user," and "advertisement charge." A system might include, e.g., means for assessing an advertisement charge, but an advertisement charge or fee charged to a user as such is not a part of a system as recited, and bears no defined structural relationship to the actual elements of the system.

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Claims 22-23, 24-26, and 29-31, are *not* rejected under 35 U.S.C. 101 or 35 U.S.C. 112, and claim 35 is not rejected based on the "media buyer," but a comment is considered appropriate. The "media buyer" of these claims might be interpreted as a human being, and human beings are not patentable. However, based on the references to an owner of a media buyer (the instant application, page 13, lines 3-9; claim 30), the media buyer is taken not to be a human being, and the claims are evaluated on that basis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-31**

Claims 1, 2, 4, 8, 9, 10, 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206). As per claim 1, Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); identifier means for identifying at least one demographic characteristic of a user, wherein the at least one demographic characteristic of the user corresponds to one of the at least one demographic indicator (inherent from column 2, lines 36-52); selector means for selecting a relevant advertisement from the set of advertisements, the selector means configured to receive the at least one demographic characteristic of the user from the identifier means, and the selector means including a comparison of the user's at least one demographic characteristic with the at least one demographic characteristic of each advertisement to select the relevant advertisement for the user (inherent from column 2, line 26, through column 3, line 5, and column 8, lines 3-10); providing an appropriate animation sequence or other Web page component based on the geographic location of a visitor is held to imply means for making necessary

comparisons, etc.); inserter means for inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, the inserter means configured to receive the relevant advertisement from the selector means so as to create an advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivery means for delivering the multimedia presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

As per claim 2, Gever discloses a hyperlink in the advertisement or other multimedia presentation (column 6, lines 13-15; Figure 4; column 8, lines 25-35; see also claim 6).

As per claim 4, Gever discloses that the multimedia presentation is an animation (Abstract; and repeated references to animation throughout the Gever patent).

As per claim 8, neither Gever nor Singh expressly discloses that the multimedia presentation includes at least two embedded placeholders, but Gever discloses creating one or more individualized Web page components (column 2, lines 9-11), and it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the multimedia presentation include at least two embedded placeholders, for the obvious advantage of presenting several advertisements, other Web page components, or parts thereof.

As per claim 9, Gever discloses multiple advertisements (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10). Neither Gever nor Singh expressly discloses that there are multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, but it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for there to be multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, for the obvious

advantage of presenting multiple ads, at different points in a web site, and/or at different times during a multimedia presentation.

As per claim 10, Gever discloses that the identifier means can include cookies generated by an Internet browser of the user (column 15, line 60, through column 16, line 8, the browser being held to follow from the cookies and other Internet-related procedure, as in column 1, lines 11-21).

As per claim 11, Gever discloses that the identifier means can include a survey completed by the user (column 15, line 49, through column 16, line 8).

As per claim 12, Gever does not expressly disclose that the inserter means is a computer program, but does disclose that the inserter means involves manipulating Web pages (column 2, line 14 through column 3, line 5; and column 8, lines 3-10), and discloses prior art programs for preparing Web pages (column 1). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the inserter means to be (or comprise) a computer program, for the obvious advantage of inserting relevant advertisements automatically according to demographics and other factors, without having to employ a human being to monitor Web traffic and make insertions by hand.

As per claim 15, Gever discloses that the components of a Web page (which, as above, may be multimedia presentations, or parts of a multimedia presentation) may not be situated on a server, but only referenced by URL address (which implies being stored on a second server elsewhere) (column 15, lines 3-16).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 2 above, and further in view of official notice. Gever does not expressly disclose that the hyperlink in the advertisement is a hyperlink to an advertiser's website (although "LINK1 = 'WWW.BUYLATER.COM'" in Figure 4 is highly suggestive). However, official notice is taken that it is well known for advertisements to contain hyperlinks to an advertiser's website. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the hyperlink in the advertisement to be a hyperlink to an advertiser's website, for the obvious advantage of encouraging users to browse catalogs, etc., and make purchases at the advertiser's website.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 4 above, and further in view of official notice. As per claim 5, Gever does not disclose that the animation is created using Flash, but official notice is taken that Flash is a well-known system for animations. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the animation to be created using Flash, for the obvious advantage of readily creating animations viewable by many client systems.

As per claim 6, Gever does not expressly disclose that the animation is an original presentation, but official notice is taken that it is well known for animations to be original presentations (not all animations could be copies of each other). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the Flash animation to be an original presentation, for

the obvious advantage of enabling the presenter to provide an animation according to his own desires and tastes, and to avoid having to pay royalties to someone else for use of a copied presentation.

As per claim 7, Gever discloses selecting from a plurality of pre-existing animation sequences (column 2, lines 9-20), an embedded placeholder presumably being added, as per Singh, to enable the desired pre-existing or modified animations to be displayed as desired.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 1 above, and further in view of official notice. Gever does not expressly disclose that the computer program is Generator, but official notice is taken that Macromedia Generator is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use it, for the obvious advantage of accomplishing the creation of Flash or similar animations using a standard, widely available package for that purpose.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 12 above, and further in view of official notice. Gever does not expressly disclose that the computer program and the multimedia presentation are stored on the same server, but official notice is taken that it is well known for various programs, data files, etc., to be stored on the same server. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer program and the multimedia presentation both stored on the first server, for the obvious advantage of ready accessibility.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 1 above, and further in view of official notice. As per claim 16, Gever discloses delivery over a connection between a server storing the Web page component (which can be a multimedia presentation, as above) and discloses a viewer/user to whom pictures are transmitted, implying a computer operated by the user (column 9, lines 46-55). Gever does not expressly disclose that the connection is an Internet connection, but does refer to network connections and a Web page component. Official notice is taken that the Internet is a well-known network, and that the World Wide Web is part of the Internet. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the network connection to be an Internet connection, for the obvious advantage of connecting to the enormous number of people who access the Internet.

As per claim 17, Gever does not disclose a syndication network, but official notice is taken that syndication networks (as defined by the instant specification, page 10, lines 19-21) are well known, e.g., advertisers who supply banner ads to one or more Websites for publication. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the system to comprise a syndication network, for the obvious advantage of placing advertisements or other desired components on multiple Web sites.

Claims 18, 19, 20, 21, 24, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh and official notice as applied to claim 17 above, and further in view of Kauffman et al. (U.S. Patent Application Publication

2002/0073084). As per claim 18, Kauffman teaches a syndication network collecting a multimedia presentation and a selected advertisement, and delivering the multimedia presentation containing the selected advertisement to the user's computer (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

As per claim 19, Kauffman teaches that the syndication network collects the multimedia presentation and the selected advertisement separate from one another, and a server in the syndication network inserts the selected advertisement into the multimedia presentation (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

As per claim 20, neither Gever nor Kauffman discloses a syndication network that collects the multimedia presentation having the selected advertisement inserted therein previous to entering the syndication network, but official notice is taken that it is well known to collect presentations or programs having advertisements already inserted therein (an example would be TV stations receiving and broadcasting national programs with nationwide advertisements already inserted by the networks). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the syndication network collect the multimedia

presentation having the selected advertisement inserted therein previous to entering the syndication network, for the obvious advantage of distributing presentations with ads already included, the ads being either likely to be of interest to many viewers in general, or likely to be of interest to many viewers of the multimedia presentation.

As per claim 21, Kauffman teaches that the syndication network collects information relating to the identifier means from the user's computer (or other device), and delivers the identifier information to a rule server (selection means) which selects appropriate advertisements (see especially paragraph 19; also Figure 1). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

As per claim 24, Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but official notice is taken that media buyers brokering advertising space, etc., are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Kauffman teaches identifier information from the syndication network being delivered to a rule server/selector means (paragraph 19; Figure 1), as in claim 21, and delivering the identifier information to the media buyer is not a significant distinction, inasmuch as the media buyer places relevant advertisements in appropriate places.

As per claim 25, Kauffman does not teach that the identifier information is delivered from the syndication network to the media buyer and from the media buyer to the selector means, but official notice is taken that it is well known to forward information from one party to another. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to deliver the identifier information from the syndication network to the media buyer and from the media buyer to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

As per claim 26, Kauffman does not teach that the identifier information is delivered from the syndication network to the media buyer, and the identifier information is also delivered from the syndication network to the selector means, but official notice is taken that it is well known to deliver information to multiple concerned parties (for example, CC'ing emails). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the identifier information is delivered from the syndication network to the media buyer and also to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 1 above, and further in view of official notice. As per claim 22, Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but official notice is taken that media buyers brokering advertising space, etc., are well known. Hence, it would have

been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

As per claim 23, Gever does not disclose that the media buyer receives information relating to the identifier means from the user's computer, but official notice is taken that it is well known for advertisers to receive information relating to identifier means from a user's computer. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the media buyer to receive information relating to identifier means from a user's computer, for such obvious advantages as determining what advertisements to present to a user (based on demographics, etc.), billing for presentation of relevant advertisements to users in relevant categories, and enabling the advertiser/media buyer to contact the user if the user expresses interest, orders goods or services, etc.

Claims 27, 28, 29, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 1 above, and further in view of official notice. As per claim 27, Gever does not disclose an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, but official notice is taken that it is well known to charge the sponsors of advertisements for running or displaying their ads. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have an advertisement charge to the sponsor of the selected advertisement delivered in the

multimedia presentation, for the obvious advantage of making money from displaying the selected advertisement.

As per claim 28, Gever does not disclose that the sponsor's advertising charge is paid to an owner of the multimedia presentation, but official notice is taken that it is well known for advertising charges to be paid to the owners of programs in which the ads appear. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertising charge to be paid to an owner of the multimedia presentation, for the obvious advantage of making money for displaying ads in multimedia presentations, or, from another perspective, for the obvious advantage of persuading the owners of multimedia presentations to display one's ads.

As per claim 29, Gever does not disclose that the sponsor's advertisement charge is apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement, but official notice is taken that it is well known to make payments (commissions) to media buyers; for payments to owners of multimedia presentations, see rejection of claim 28 above. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertisement charge to be apportioned to a group comprising an owner of the multimedia presentation and an owner of a media buyer providing the selected advertisement, for the reasons set forth above in rejecting claim 28, and for the obvious advantage of compensating a media buyer for its services in placing ads.

As per claim 30, Gever does not disclose that the sponsor's advertisement charge is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the selected advertisement, and an owner of the delivery means for providing the multimedia presentation to the user, but official notice is taken that it is well known to make payments to owners of delivery means (websites, ISP's, cable TV companies, etc.); for payments to owners of multimedia presentations and media buyers, see rejection of claims 28 and 29 above. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertisement charge to be apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer providing the selected advertisement, and an owner of the delivery means for providing the multimedia presentation to the user, for the reasons set forth above in rejecting claims 28 and 29, and for the obvious advantage of compensating the owner of delivery means for his services in allowing an ad to run, or from the other perspective, of profiting from running ads.

As per claim 31, Gever does not disclose that the delivery means is a syndication network, but official notice is taken that syndication networks (as defined by the instant specification, page 10, lines 19-21) are well known, e.g., advertisers who supply banner ads to one or more Websites for publication. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the delivery means to be a syndication network, for the obvious advantage of placing advertisements or other desired components on multiple Web sites.

It is noted that claims 1-31 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

### **Claims 32-34**

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206). Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); identifier means for identifying a user (inherent from column 2, lines 36-59); selector means for selecting a relevant advertisement from the set of advertisements, wherein the selector means select the relevant advertisement subsequent to the identification of the user by the

identifier means (column 2, line 26, through column 3, line 5, and column 8, lines 3-10); inserter means for inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, the inserter means configured to receive the relevant advertisement from the selector means so as to create a seamless advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivery means for delivering the multimedia presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 32 above, and further in view of official notice. Gever does not disclose that the selector randomly selects the advertisement, but official

notice is taken that randomly selecting an item from a list is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the selector to randomly select the advertisement, for the obvious advantage of choosing an advertisement when there is no particular reason to choose one advertisement over another.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever and Singh as applied to claim 32 above, and further in view of Kauffman et al. (U.S. Patent Application Publication 2002/0073084). Gever does not expressly disclose that the seamless advertisement is dynamically contained in the multimedia presentation, but Kauffman teaches this (paragraphs 17-20). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for seamless advertisement to be dynamically contained in the multimedia presentation, for the obvious advantage of presenting dynamic advertisements to viewers.

It is noted that claims 32-34 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**Claim 35**

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206), Kauffman (U.S. Patent Application Publication 2002/0073084) and official notice. Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); cookies generated by an Internet browser of a user for identifying at least one demographic characteristic of the user (column 15, line 60, through column 16, line 8, the browser being held to follow from the cookies and other Internet-related procedure, as in column 1, lines 11-21); selector means for selecting a relevant advertisement from the set of advertisements, the selector means configured to receive at least one demographic characteristic of the user (column 2, line 26, through column 3, line 5, and column 8, lines 3-10). Gever does not expressly disclose the selector means comparing the user's cookies with the demographic indicators of advertisements, but given the disclosure of cookies, and of selecting advertisements or other Web page components based on demographic characteristics, this is obvious. Gever discloses inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, creating an

advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not disclose a syndication network, but Kauffman teaches a syndication network for delivering a multimedia presentation to a user over an Internet connection between a first server storing the multimedia presentation and a computer or other device operated by the user (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a syndication network do this, for the stated advantage of incorporating advertising to target particular end users.

Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but official notice is taken that

media buyers brokering advertising space, etc., are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Kauffman teaches identifier information from the syndication network being delivered to a rule server/selector means (paragraph 19; Figure 1), and delivering the identifier information to the media buyer is not a significant distinction, inasmuch as the media buyer places relevant advertisements in appropriate places. Kauffman does not expressly teach that the identifier information is delivered from the syndication network to the media buyer, and the identifier information is also delivered from the syndication network to the selector means, but official notice is taken that it is well known to deliver information to multiple concerned parties (for example, CC'ing emails). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the identifier information is delivered from the syndication network to the media buyer and also to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

Gever discloses a hyperlink in the advertisement or other multimedia presentation (column 6, lines 13-15; Figure 4; column 8, lines 25-35; see also claim 6). Gever does not expressly disclose that the hyperlink in the advertisement takes the user to an advertiser's website (although "LINK1 = 'WWW.BUYLATER.COM'" in Figure 4 is highly suggestive). However, official notice is taken that it is well known for

advertisements to contain hyperlinks to an advertiser's website. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the hyperlink in the advertisement to take the user to an advertiser's website, for the obvious advantage of encouraging users to browse catalogs, etc., and make purchases at the advertiser's website.

Gever does not disclose a fee charged to the user for delivery of the multimedia presentation, but official notice is taken that it is well known to charge fees to users for viewing desirable content, fees being apportioned to one or more of the content owner, the owner of a delivery system, and/or the owner of a media buyer. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to charge such a fee, for the obvious advantages of profiting from providing the services of providing and delivering content, and attracting advertisements by paying commissions to buyers.

Gever does not disclose an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, but official notice is taken that it is well known to charge the sponsors of advertisements for running or displaying their ads. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, for the obvious advantage of making money from displaying the selected advertisement. Gever does not disclose that the advertisement charge is apportioned to a group comprising an owner of the multimedia presentation, an owner of a media buyer

providing the selected advertisement, and an owner of the delivery means used for providing the multimedia presentation to the user, but official notice is taken that it is well known for advertising charges to be paid to the owners of programs in which the ads appear, that it is well known to make payments (commissions) to media buyers, and that it is well known to make payments to the owners of delivery means for providing presentations to users (e.g., TV and cable stations). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertising charge to be paid in part to an owner of the multimedia presentation, for the obvious advantage of making money for displaying ads in multimedia presentations, or, from another perspective, for the obvious advantage of persuading the owners of multimedia presentations to display one's ads; in part to an owner of a media buyer providing the selected advertisement, for the obvious advantage of compensating a media buyer for its services in placing ads; and in part to an owner of the delivery means, for the obvious advantage of compensating the owner of the delivery means for delivering the data, including ads.

Gever does not expressly disclose the use of Flash or Macromedia Generator, but official notice is taken that these are well-known systems for animations. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the animation to be created using Flash, and for the advertisement to be inserted using Macromedia Generator, for the obvious advantage of readily creating animations viewable by many client systems.

Gever does not expressly disclose that the animation is an original presentation, but official notice is taken that it is well known for animations to be original presentations (not all animations could be copies of each other). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the Flash animation to be an original presentation, for the obvious advantage of enabling the presenter to provide an animation according to his own desires and tastes, and to avoid having to pay royalties to someone else for use of a copied presentation.

Gever does not expressly disclose that there are multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, but it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for there to be multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, for the obvious advantage of presenting multiple ads, at different points in a web site, and/or at different times during a multimedia presentation.

It is noted that claim 35 uses "means for" language ("selector means"). Nonetheless, it is not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**Claim 36**

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206). Gever discloses an Internet advertising method comprising: providing a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); providing a set of advertisements corresponding to the embedded placeholder, each advertisement being indexed by at least one demographic indicator (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); identifying at least one demographic characteristic of a user(inherent from column 2, lines 36-52); selecting a relevant advertisement from the set of advertisements, the advertisement selection including a comparison of the user's at least one demographic characteristic with at least one demographic characteristic of each advertisement to select the relevant advertisement for the user (inherent from column 2, line 26, through column 3, line 5, and column 8, lines 3-10; providing an appropriate animation sequence or other Web

page component based on the geographic location of a visitor is held to imply means for making necessary comparisons, etc.); inserting the relevant advertisement into the embedded placeholder of the multimedia presentation, creating an advertisement programmed to dynamically follow the series of actions of the given item integrated within the multimedia presentation and targeted to the user's demographic characteristics (inherent from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivery means for delivering the multimedia presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

**Claim 37**

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206), Kauffman (U.S.

Patent Application Publication 2002/0073084) and official notice. Claim 37 is closely parallel to claim 35, and rejected on essentially the same grounds.

### ***Response to Arguments***

Applicants' arguments filed May 16, 2005 have been fully considered but they are not persuasive; they are also mooted in part by new art cited in making the rejections, and by explicit official notice of well-known facts. Applicants argue that Gever differs from Applicants' invention in that it requires scenes and frames to be stored on a server, which would be impractical for large website animations, or a large number of combinations of placeholders and advertisements. Leaving aside questions of how large is large, claim 1, for example recites nothing to distinguish over Gever on this ground. Claim 18 does, but is rejected with Kauffman as a secondary reference.

Applicants state they believe that Gever requires that a web designer pick the specific attributes and, at least once, create a frame or scene based on each one of the chosen attributes; whereas the present invention does not require such manipulation by a web designer for each specific advertisement. Examiner replies that there is nothing in Gever requiring the earlier invention to be read so narrowly, and even if there were, that could still qualify as "the selector means selecting the relevant advertisement subsequent to the identification of the user by the identifier means," since the server in Gever chooses what to display based on identification of the user individually or by category (such as vegetarian or non-smoker; see Figure 5 of Gever). Nothing in Gever teaches against embedded placeholders being filled "on the fly" based on a multitude of

viewer characteristics, even if that were an express limitation of any of Applicants' claims, which it is not. Granted, Gever does not expressly disclose a plurality of placeholders and a plurality of sets of advertisements, but duplicating known parts is held to be obvious (see rejections of claims 8 and 9 above).

Applicants' arguments regarding claim 32 are essentially similar to the arguments presented regarding claim 1 above. Moreover, Applicants' later arguments directed to claim 36 in particular make no significant points not already made with regard to other claims; therefore, Examiner's replies are reiterated.

Regarding claim 37 (and parallel claim 35), Applicants list the claim limitations, and argue that Gever not disclose at least some of them. Examiner replies that Gever does not disclose an original, Flash animation multimedia presentation, but does disclose providing an animation, and Flash is a well-known tool which Applicants do not claim to have invented. Gever does not disclose providing at least two placeholders, and multiple sets of advertisements, but Examiner holds that this is a matter of duplicating known features, and thus held to be obvious to one of ordinary skill. Examiner points out that Gever does disclose identifying cookies, as set forth in the rejections above, and Gever does disclose selecting presenting advertisements or other Web page components based on user identification, which makes it obvious to do so based on the cookies. Gever does not expressly disclose using Macromedia Generator, but, like Flash, this is a well-known tool which Applicants do not claim to have invented, and is therefore held not to make an otherwise obvious system or method non-obvious.

Regarding claims 27-31, Examiner agrees these recite features which are not disclose in Gever, but these claims are now rejected on a changed combination of Gever, Singh, and official notice, and it is not believed that such well-known features as charging a sponsor for running his advertisement can make an otherwise obvious claim non-obvious.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Day et al. (U.S. Patent 5,996,015) disclose a method of delivering seamless and continuous presentation of multimedia data files to a target device by assembling and concatenating multimedia segments in memory. Cottingham (U.S. Patent 6,339,761) discloses an Internet service provider advertising system. Servan-Schreiber et al. (U.S. Patent 6,892,354) disclose a method of advertising on line during a communication link idle time.

Benthin et al. (U.S. Patent Application Publication 2002/0035568) disclose a method and apparatus supporting dynamically adaptive user interactions in a multimodal communication system. Landsman et al. (U.S. Patent Application Publication 2003/0023488) disclose a technique for implementing interstitial Web advertising through use of an ad descriptor file. Strasnich et al. (U.S. Patent Application Publication 2003/0182184) disclose advertising based on pre-computed distributed playlists.

Yoshitake et al. (Japanese Published Patent Application 11-85783 A) disclose an advertising information providing system. Dolgachev (WO 00/78046 A1) discloses distributing an advertisement over a network.

Tedesco ("Web Ads Get Glitz, Savvy") discloses streaming video ads. McCormack ("LowestFare.com Tests Rich Media Ads") discloses targeted streaming video ads. The anonymous article, "Spinway Surpasses 4 Million Registered Consumers on Its Internet Advertising Network," discloses targeting viewers for ads by demographics, geographics, etc. The anonymous article, "AdForce and Activate Deliver Next Generation Web Advertising," discloses delivering personalized ads..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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*Nicholas D. Rosen*  
NICHOLAS D. ROSEN  
PRIMARY EXAMINER

August 11, 2005